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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/814,066
Filing Date: June 21, 2001
Appellant(s): KNAUSEDER, FRANZ

Greenblum & Bernstein, P.L.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 28, 2008 appealing from the Office action mailed July 28, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------------|-----------------|---------|
| 5,157,892 | Ryther | 10-1992 |
| 5,165,816 | Parasin | 11-1992 |
| 5,678,715 | Sjostedt et al. | 10-1997 |
| 6,004,417 | Roesch et al. | 12-1999 |
| 6,398,902 | Robins et al. | 6-2002 |
| AT 405,560 | Kaindl | 9-1999 |
| DE 29,703,962 | Witex Co. | 6-1997 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-3, 21-24, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962).

Kaindl '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application. Kaindl '560 does not appear to disclose any specific use of adhesive with the attaching configuration.

However, Witex Co. '962 teaches utilization of a pre-applied contact adhesive 7/9, 8/9 between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. Witex Co. '962 discloses a "contact glue" as well as a glue activated by heat with both disclosed as pre-applied at the factory, (see translation of Witex Co. '962 as at page 4, line 19 to page 5, line 4; page 5, line 20 to page 6, line 6; page 7, lines 6-11; and page 8, lines 2-5 and 10-13).

Therefore, to have provided the floor tile assembly of Kaindl '560 with adhesive, including a pre-applied adhesive, between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Witex Co. '962. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Witex Co. '962 teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site").

As concerns **claim 3**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of

the tongue provided with the adhesive, (i.e., "the grooves of the individual panels are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a filling, a coating, a covering, or a strand, and the tongues are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a coating, a surface impregnation, a covering, or a strand"), page 9, lines 5-7 of the translation of Witex Co. '962 which teaches application of layer or strand or coating 7/9 along the groove and layer or strand or coating 8/9 along the tongue.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6, page 5, lines 7-9 and page 8, lines 4-6.

Claims 1-3, 21-24, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of Roesch et al.

Though the limitation presented within each of claims 1, 31, and 34 to "pre-applied adhesive layer" is deemed met by the above rejection of claims 1-3, 21-24 and 31-35 over Kaindl in view of Witex Co., Roesch et al., for example, teaches utilization

and advantages of various pre-applied adhesives within a tongue and groove joint. Roesch et al. recognizes as old and well known the use of "two component" adhesives including a) separately microencapsulating epoxy resin as one component and a curing agent as a second component; or b) the use of two component solvent adhesives that are separately microencapsulated; or c) the use of a separately encapsulated polymerization activator dispersed within a second component solution of polymerizable monomers and a polymerization catalyst with the first component polymerization activator being released and mixed with the second component solution, (col. 2, lines 34-48), such adhesives falling into a category of pre-applied two component adhesive. Roesch et al. teaches application to either one or both members being connected, col. 10, line 9. Roesch et al. further teaches application to either one or both members "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site"), col. 10, lines 36-40 and col. 5, lines 54-58.

Therefore, to have provided the modified floor tile assembly of Kaindl '560 with a pre-applied two component adhesive, (including adhesive with activating substance, microencapsulated adhesive, etc.), between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly "two component adhesives", would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Roesch et al. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of

manufacture. However, Roesch et al. obviously teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site"). Further, Roesch et al. teaches application and utilization of a two component adhesive within a tongue and groove joint.

As concerns **claim 3**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive, (i.e., "the grooves of the individual panels are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a filling, a coating, a covering, or a strand, and the tongues are provided with the pre-applied adhesive layer, or the pre-applied layer of a substance which activates an adhesive having the form of a coating, a surface impregnation, a covering, or a strand"), page 9, lines 5-7 of the translation of Witex Co. '962.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as is taught by Witex Co. '962 on page 4, lines 1-6, page 5, lines 7-9 and page 8, lines 4-6.

As concerns **claim 36**, the resulting panels would have at least one component of a two-component glue along a first, (or tongue), edge and at least another component of the two-component glue along a second, (or groove), edge.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), as applied to claims 1-3, 21-25, and 31-35 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering Roesch et al. as applied to claims 1-3, 21-25, and 31-36 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther.

(10) Response to Argument

Re Appellant's arguments within section (VII)-A of the brief:

Appellant's arguments with respect to claims 31, 34 and 3 appear the same as Appellant's arguments with respect to claim 1. Therefore, only arguments directed to claim 1 are being addressed.

1) With respect to Appellant's argument that Witex Co. does not teach a "pre-applied adhesive layer", in acknowledging that the Witex Co. '962 reference discloses a "contact glue" pre-applied at the factory, (the Witex Co. '962 reference also discloses a glue activated by heat), Appellant argues that the "pre-applied adhesive" of the instant claims is limited to that which is disclosed by U.S. Patent 4,417,028 to Azevedo, (see Appellant's arguments within the second paragraph on page 12 of the brief on appeal). However, Examiner knows of no such restrictive definition of "pre-applied adhesive" that would preclude a reading of any ordinary adhesive or particularly, that pre-applied adhesive used within the Witex Co. '962 reference. Indeed, the adhesives envisioned by the instant application include those activated by contact or "contact adhesive" as is expressed at lines 1-3 on page 6 of the instant specification. The Witex Co. '962 reference sets forth such contact adhesive as well as adhesives activated by heat. Indeed, the instant specification, (as at lines 19-23 on page 5, lines 1-5 on page 6, and lines 22 on page 8 to line 17 on page 9), also includes "physically setting cements", "contact glues", and "adhesive glues" which is met by any type adhesive.

Examiner is not aware that the term "pre-applied adhesive" must be taken to specifically define what is disclosed in U.S. patent No. 4,417,028. However, the term to

"pre-applied" does not serve to establish only those adhesives described within U.S. patent No. 4,417,028. As has been set forth throughout prosecution of the instant application the term to pre-applied is taken to set forth an application, (of adhesive in this instance), prior to any other given step or procedure, (see for example, page 7 of the brief where Appellant emphasizes "applied off-site". This is met by the combination of references used against claims 1, 31, and 34. Examiner reasons that the term pre-applied coupled with the term adhesive as used in the art, as by U.S. patent No. 4,417,028, is meant to characterize the adhesive as "applied off-site" or applied "prior to the time of assembly" or "preapplied at the factory" and not otherwise to any specific type of adhesive. Thus, as broadly accepted, the term to "pre-applied adhesive" is met by the combination of references used against claims 1, 31, and 34 since the adhesive applied to the modified Kaindl '560 reference is applied prior to actual joining of the members as well as prior to the actual final assemblage of the cladding members to form a substrate, (though this is not relevant since claims 1, 31, and 34 merely set forth an adhesive upon a joint end of a cladding board which is what the modified Kaindl '560 reference discloses. See *In re Fessman*, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985).

Appellant's prosecution of the instant application would seem to verify Examiner's interpretation of the term to "pre-applied adhesive". For example, independent claim 34 recites;

"a *pre-applied first layer* arranged on at least one surface of the groove at least in an area of the divergent sides and a *pre-applied second layer* arranged on

at least one surface of the tongue at least in an area of the divergent wedge shape, *wherein each of the pre-applied first and second layers comprises an adhesive layer* or a pre-applied layer of a substance which activates an adhesive."

With the above claim recitation, Applicant is apparently addressing the question of whether or not the adhesive is applied prior to an ensuing step or procedure and not the particular adhesive itself. In other words, Applicant is using "pre-applied" as a modifier to establish *when* a substance has been applied, not *what* substance has been applied. Further, at page 16 in Applicant's response of June 24, 2005 Applicant argues that "Roesch does not disclose or suggest a pre-applied adhesive layer...much less, [adhesives]...which are applied off-site." See also, Appellant's emphasis of "is applied off-site" on page 7 of the instant brief on appeal. Clearly, Applicant's arguments have been directed to when or where the adhesive is applied and not what type of adhesive is applied.

At any rate, the Witex Co. reference, (DE 29,703,962), does disclose an adhesive that is applied off-site only to be activated at a later point in time thus, meeting Appellant's definition of pre-applied adhesive namely, "typically stable compositions which are prepared and pre-applied to 'surfaces prior to the time of assembly, which will remain on the parts during normal storage and shipment, and which will cure upon mating with another part thereby imparting an effective and improved seal or bond'." See for example, translation of Witex Co. '962 as at page 4, line 19 to page 5, line 4; page 5, line 20 to page 6, line 6; page 7, lines 6-11; and page 8, lines 2-5 and 10-13).

2) With respect to Appellant's arguments that Witex Co. '962 teaches away from the teachings of Kaindl '560, the resulting Kaindl '560 flooring assembly would possess locking elements as well as an adhesive bond that would help ensure a secure connection between adjacent flooring panels. Each of Kaindl and Witex Co. desire and teach a secure connection between flooring panels. Thus, Kaindl and Witex Co. do not present divergent teachings. The combination of Kaindl and Witex Co. would form a very secure joint with both the interlocking of the tongue with groove as well as the application of adhesive between tongue and groove. Appellant argues,

Moreover, DE '962 merely discloses a contact glue which requires that the mating surfaces "be pressed together with a considerable degree of pressure, making it impossible to additionally adjust the glued joint in the longitudinal direction for the purpose of closing a transverse joint."

Initially, Appellant's use of quotations is not clear as the Witex Co. reference does not express what Appellant presents in quotes within the above remark. Secondly, Appellant's remark appear directed to a method of assembly when the claims are directed to an article of manufacture. At any rate, and contrary to Appellant's assertion, Witex Co. does teach allowing for manipulation of the floor boards after activation of the pre-applied adhesive as is set forth in Witex Co. at lines 7-13 on page 6 and lines 6-11 on page 7 of the Witex Co. translation. Thus, Witex Co. teaches application of a pre-applied adhesive that allows one "to additionally adjust the glued joint in a longitudinal direction for the purpose of closing a transverse joint."

3) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, as stated in the specific rejections of claims 32, 33, and 35, Examiner has recognized that it would have been obvious to one having ordinary skill in the art to desire application of an adhesive so as to avoid any excess spillage to thus maintain the aesthetic integrity of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 7-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

Re Appellant's arguments within section (VII)-B of the brief:

Appellant's arguments with respect to claims 31, 34 and 3 appear the same as Appellant's arguments with respect to claim 1. Therefore, only arguments directed to claim 1 are being addressed.

4) With respect to Appellant's arguments against the rejection of claims 1, 31 and 34 as rejected under Kaindl in view of Witex Co. and Roesch et al., one having ordinary skill in the art would certainly turn to the Roesch et al. teaching of an adhesive attachment of pipes, fittings, and connectors when determining what specific adhesives could be used in the assembly of inter-fitting, (i.e., tongue and groove), structural elements. Thus, Roesch is analogous art since one of ordinary skill in the art would look to the adhesive subject matter of Roesch when attempting to establish an appropriate adhesive for glued joints. Indeed, Roesch deals with one member fitting within another.

5) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, as stated in the specific rejections of claims 32, 33, and 35, Examiner has

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recognized that it would have been obvious to one having ordinary skill in the art to desire application of an adhesive so as to avoid any excess spillage to thus maintain the aesthetic integrity of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 7-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

Re Appellant's arguments within section (VII)-C of the brief:

6) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, as stated in the specific rejections of claims 32, 33, and 35, Examiner has recognized, (as is taught by any of Robins et al., Sjostedt et al., Parasin, and Ryther), that it would have been obvious to one having ordinary skill in the art to desire application of an adhesive so as to avoid any excess spillage to thus maintain the aesthetic integrity of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 7-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 7-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

Re Appellant's arguments within section (VII)-D of the brief:

7) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, each of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892 had

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been utilized to suggest and teach applying an adhesive in a manner to avoid excess adhesive to spill out onto the surrounding surface of a joint assembly. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther. Further, the Witex Co. '962 reference teaches, (as at lines 7-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M. Safavi /Michael Safavi/
Primary Examiner

Conferees:

Marc Jimenez /MJ/

Lanna Mai (Darnell Jayne for) /dj/